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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Craig W. BARNETT *et al.*
SERIAL No.: 09/879,823
ATTORNEY DOCKET NO: 031792-0311530 (24122-303-408)
FILING DATE: June 12, 2001
ART UNIT : 3622
EXAMINER A. DURAN
FOR: METHOD AND SYSTEM FOR ELECTRONIC DISTRIBUTION
OF PRODUCT REDEMPTION COUPONS

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

Appeal No. 2005-2686

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Decision on Appeal mailed **February 8, 2006** in the above-captioned application, Appellants respectfully submit this Request for Rehearing under 37 C.F.R. § 41.52. This Request is being timely filed within two months of the date of the Decision of the Board of Patent Appeals and Interferences.

It is believed that no fees are due in connection with the filing of this Request. In the event that it is determined that fees are due, however, the Director is hereby authorized to charge the undersigned's Deposit Account No. 033975 (**Ref. No. 031792-0311530**).

I. INTRODUCTION

In sustaining the rejection under 35 U.S.C. § 102(b) in the February 8, 2006 Decision on Appeal (hereinafter “Decision”), the Board of Patent Appeals and Interferences (hereinafter “Board”) used a newly devised rationale, which was not applied by the Examiner. Thus, this is a new ground of rejection made pursuant to 37 C.F.R. § 41.50(b), to which Appellants have not fairly had an opportunity to respond. Based on this new ground of rejection, Appellants request that the case be remanded to the Examiner to reopen prosecution to permit Appellants to address the new ground of rejection.

To the extent that the Board does not declare its Decision a new ground of rejection, Appellants submit this Request for Rehearing under 37 C.F.R. § 41.52 in response to the Decision. Appellants respectfully request rehearing for consideration of the legal and factual errors underlying the Board’s determination of anticipation under 35 U.S.C. § 102(b), and the Board’s determination that the claims do not satisfy the written description requirement of 35 U.S.C. § 112, ¶1.

The Board erred by:

- A. Affirming the rejection of claim 61 under U.S.C. § 112, ¶1, when it erroneously relied on a recitation not present in the claim;
- B. Affirming the rejection under 35 U.S.C. § 102(b) using a new ground of rejection to which Appellants have not fairly had an opportunity to respond;
- C. Affirming the rejection under 35 U.S.C. § 102(b) by relying on passages of Von Kohorn that neither expressly nor inherently disclose each of the elements of *at*

least independent claims 47, 52, 57, 61, and 62;

- D. Interpreting the Von Kohorn reference in a manner that directly conflicts with an earlier Board Decision in a related, co-pending application;
- E. Affirming the rejection under 35 U.S.C. § 112, ¶1 by inconsistently interpreting the same claim language (“predetermined number”) for purposes of anticipation and lack of written description; and
- F. Affirming the rejection under 35 U.S.C. § 112, ¶1 by improperly importing limitations into the claim, and based on alleged “unsupported” features that it does not recite.

In view of these errors, Appellants request that the Decision be vacated and the Final Rejection of the Examiner reversed. Alternatively, based on the new ground(s) of rejection, the Decision should be vacated and the application remanded to the Examiner for further consideration.

II. BACKGROUND

A. THE INVENTION

The above-captioned application was filed June 12, 2001, and claims priority to U.S. Patent Application Serial No. 08/425,185 filed April 19, 1995 (now U.S. Patent No. 6,321,208 B1, issued November 20, 2001). Of pending claims 47-62, claims 47-60 were copied from, and correspond identically to, claims 1-14 of U.S. Patent No. 6,075,971 to Williams *et al.* for the purpose of provoking an Interference with that Patent. Pending claims 61-62 were added during prosecution.

The claimed invention is directed to a system and method for providing coupons to a device coupled to a network. A target audience of one or more users of devices coupled to a network is determined based on one or more preferences of the users stored in the respective users' devices. A coupon is provided to the determined target audience and coupon redemption is monitored such that each coupon may be used a predetermined number of times. Independent claim 47 is reproduced below:

47. A method comprising:
determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices; and
providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:
determining a subset of users of the network based on a preference profile;
delivering one or more coupons to the subset of users; and
monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

B. APPELLATE PROCEDURAL HISTORY

On August 10, 2004, Appellants filed a Notice of Appeal in response to the Examiner's July 12, 2004 Office Action (hereinafter "Final Action") finally rejecting pending claims 47-62 under 35 U.S.C. § 112, ¶1 and 35 U.S.C. § 102(b). With regard to the 35 U.S.C. § 112, ¶1 rejections, the Examiner alleged that Appellants' specification lacks support for the phrases "wherein each coupon may be used *a pre-determined number of times*,"¹ and "monitoring redemption of the one or more coupons such that each coupon may be used *a predetermined*

¹ The examiner did not reject claim 61 based on the "predetermined number of times" recitation.

number of times” as recited in claims 47, 52, 57, & 62 [Final Action, pgs. 2-3] (the “Predetermined Number of Times Recitation”). The Examiner further alleged that Appellants’ specification lacks support for the phrase “preferences of respective users stored in the respective user’s devices,” as recited in claims 47, 52, 57, **61**, & 62 [Final Action, pgs. 3-4].² Claims 47-62 were rejected under 35 U.S.C. § 102(b) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn [Final Action, pg.4].

Appellants’ Brief on Appeal (hereinafter “Appeal Brief”) was filed on February 10, 2005. In the Appeal Brief, Appellants argued that the claims 47-62 are fully supported by the as-filed specification and, as such, the written description requirement of 35 U.S.C. § 112, ¶1 is satisfied. Appellants further argued that the rejection under 35 U.S.C. § 102(b) was improper as the cited portions of Von Kohorn neither expressly nor inherently disclose each of the features of claims 47-62.

The Examiner’s Answer (hereinafter “Answer”) was mailed April 1, 2005. Appellants filed a Reply Brief on May 31, 2005, and an Oral Hearing was held on January 11, 2006.

In the February 8, 2006 Decision, the rejection of claims 47-62 under 35 U.S.C. §112, ¶1 was sustained [Decision, pgs. 4-7]. The Board determined that the “Pre-determined Number of Times Recitation,” as recited in claims 47, 52, 57, & 62 was not supported by Appellants’ specification [Decision, pgs. 4-6]. The Board further determined that the phrase “preferences of respective users stored in the respective user’s devices,” as recited in claims 47, 52, 57, **61**, & 62 was supported by Appellants’ specification [Decision, pgs. 6-7].

² This was the only basis for rejecting claim 61 under 35 U.S.C. § 112, ¶1.

The rejection of claims 47-62 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,227,874 to Von Kohorn was sustained, albeit on different grounds than those relied on by the Examiner [Decision, pgs. 7-12].

Rehearing is requested for the rejections under 35 U.S.C. §112, ¶1 and 35 U.S.C. § 102(b).

III. STANDARD OF REVIEW

As a tribunal of the U.S. Patent and Trademark Office, the Board of Patent Appeals and Interferences (“Board”) is governed by the Federal Administrative Procedure Act. *See In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). As such, any of the Board’s actions, findings, and conclusions which are “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law...” may be set aside. 5 U.S.C. § 706(2) (2000). *See also In re Lee*, 277 F.3d at 1342 (vacating the Board’s obviousness rejection for “failure to meet the adjudicative standards for review under the Administrative Procedure Act,” and remanding for further proceedings). In addition, the Board must present a full and reasoned explanation of its decision. *See In re Lee*, 277 F.3d at 1342 (quoting *Allentown Mack Sales and Serv., Inc. v. Nat’l Labor Relations Bd.*, 522 U.S. 359, 374 (1998) for the proposition that “[n]ot only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational”).

IV. ARGUMENT

A. THE BOARD CLEARLY ERRED IN REJECTING CLAIM 61 UNDER 35 U.S.C. §112, ¶1 BASED ON AN ALLEGED FAILURE TO SUPPORT FEATURES THAT ARE NOT RECITED IN THE CLAIM.

The Board erred in rejecting claim 61 under 35 U.S.C. §112, ¶1 [Decision, pg. 4, lines 1-9]. Even the Examiner did not reject claim 61 under 35 U.S.C. §112, ¶1 for alleged failure to disclose the “Predetermined Number of Times Recitation”.

In the Final Action, the Examiner alleged only that independent claims 47, 52, 57, & 62 lacked support for the “Pre-determined Number of Times Recitation” [Final Action, pgs. 2-3]. Claim 61 was not included in this ground of rejection. Moreover, claim 61 does not even recite the claim elements for which no support is alleged.

Independent claim 61 was rejected under 35 U.S.C. § 112, ¶1 for allegedly lacking support in the Specification only for the recitation of “preferences of respective users stored in the respective user’s devices” [Final Action, pg. 3]. However, the Board found that this recitation *was* supported by the Specification [Decision, pg. 7]. Thus, the only 35 U.S.C. §112, ¶1 rejection pertinent to claim 61 was not affirmed.

Appellants request that the Board vacate the portion of the Decision affirming the rejection of claim 61 under 35 U.S.C. § 112, ¶1. Alternatively, this is clearly a new ground of rejection.

B. THE BOARD APPLIED A NEW GROUND OF REJECTION UNDER 35 U.S.C. § 102(b).

In sustaining the rejection under 35 U.S.C. § 102(b), the Board used a rationale and support which was not applied by the Examiner. This constitutes a new ground of rejection

pursuant to 37 C.F.R. § 41.50(b). As a matter of fairness, Appellants should be afforded a full and fair opportunity to respond to this new ground of rejection. As detailed below, Appellants further submit that even this new rationale does not meet the claim language.

In the Appeal Brief (at pgs. 16-17) and Reply Brief (at pgs. 6-10), Appellants addressed the Examiner's rejection and, in particular, illustrated how the relied-upon passages in Von Kohorn failed to disclose the claimed features. In sustaining the rejection of claims 47-62 under 35 U.S.C. § 102(b), however, the Board did not apply the Examiner's rationale, nor did the Board rely on the specific passages of Von Kohorn relied upon by the Examiner. Rather, the Board relied on other passages in Von Kohorn (column 98, lines 41-44), which the Examiner did not rely on. In fact, the Board expressly stated that in its view the Examiner did not rely on the best parts of Von Kohorn. The Board stated:

Although the examiner may not have cited the best passages of Von Kohorn in support of the rejection, we agree with the examiner that the entirety of the Von Kohorn disclosure provides the evidence necessary to support the examiner's rejection. Specifically, we note that one of the many embodiments disclosed by Von Kohorn is an embodiment in which a user can select a product area of interest and, subsequently, receive an award in the form of a coupon allowing him to purchase a product in the area of interest [column 98, lines 41-44].

[Decision, pg. 10].

By relying on a new rationale for the rejection (taken from an otherwise voluminous reference which the Board acknowledged comprises "many embodiments"), the Board's grounds of rejection are different from those set forth by the Examiner. As such, Appellants have not been provided a full and fair opportunity to respond to the new rejection. *See In re Kumar*, 418 F.3d 1361, 1368, 76 U.S.P.Q.2d 1048, 1052 (Fed. Cir. 2005) (discussing *In re Waymouth*, 486 F.2d 1058, 1060-1061 (CCPA 1973) as "holding that a new rejection had occurred where the

examiner and the board rejected a claim for different reasons”); and citing *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976) (for the proposition that “the ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection”).

Throughout prosecution, the Examiner has taken a “scatter-shot” approach to the prior art rejection by selectively picking and choosing features, or in some cases, words from among the multiple embodiments of the voluminous Von Kohorn disclosure to formulate the rejection. In many instances, for each particular claim feature, the Examiner identifies several citations of Von Kohorn as allegedly disclosing the feature, but provides no explanation [*e.g.*, Final Action, pgs. 5-6]. As a result, Appellants have had to sift through numerous citations in Von Kohorn, some of which appear irrelevant to the claimed invention, in an attempt to understand the basis for the rejection. It is not reasonable in light of this and other equitable principles to expect Appellants to anticipate and address other rejections that the Board might make.

Thus, it would be manifestly unfair for the Board to rely on the new ground of rejection without providing Appellants a full and fair opportunity to respond. This is particularly true where, for at least the reasons set forth below, Appellants respectfully submit that this new ground of rejection is improper and overlooks differences between the claimed invention and the portions of Von Kohorn relied on in the new ground of rejection.

Accordingly, at a minimum, the Decision sustaining the rejection under 35 U.S.C. §102(b) should be vacated and remanded to the Examiner for further consideration, and to allow Appellants a full opportunity to respond to the new rejection.

**C. THE BOARD'S NEW REJECTION FAILS TO ESTABLISH
ANTICIPATION BY VON KOHORN.**

The rejection of claims 47-62 under 35 U.S.C. § 102(b) is legally improper for *at least* the reason that the passages of Von Kohorn relied upon by the Board neither expressly nor inherently discloses each of the elements of *at least* independent claims 47, 52, 57, 61, and 62.

Independent claims 47, 52, 57, 61, and 62 each generally recite, *inter alia*, the features of determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices, and providing a coupon to the target audience determined.

The new passages in Von Kohorn relied upon by the Board (col. 98, lines 41-44 and 60-64) do not cure the deficiencies of the Examiner's rejection, as they still fail to disclose the claimed invention. Col. 98, lines 39-45 of Von Kohorn recites:

Thus, in the case of a game show wherein advertisers' products are displayed in various areas of interest, a participant of the remote audience can select a product area of interest and, subsequently, receive an award in the form of a coupon allowing him to purchase a product in the area of interest.

Col. 98, lines 57-64 of Von Kohorn recites:

However, unlike merchandising systems of the past where coupons have been issued in areas of little interest with consequential low rates of redemption, in the case of the present invention a high rate of redemption is anticipated because of the capability afforded to participants to select areas of interest, both with respect to manufacturers' or retailers' products as well of areas of interest in terms of a participants' knowledge.

1. *The cited portions do not disclose the claim elements as whole.*

The foregoing passages do not disclose "targeting" as disclosed and claimed by Appellants. Claim 47 recites:

47. A method comprising:
- determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices; and
 - providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:
 - determining a subset of users of the network based on a preference profile;
 - delivering one or more coupons to the subset of users; and
 - monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

The passages relied upon by the Board above describe a “game show” variation of Von Kohorn’s “broadcast” system, which entails *broadcasting discount information to response units of all users* --not just to targeted users-- where the determination is then made whether or not a particular discount matches a selected user interest. Later passages in Von Kohorn provide clarification:

The extended shopping interval proceeds as follows. A list of items obtainable by purchase at a local market is set forth in a listing contained, by way of example, in a newspaper, in a mailing to householders, or on the television screen 208 along with identifying numbers which are provided also to the memory of the response unit via the instructional signal. The listing may comprise all of the products obtainable from a manufacturer or from a retailer, even if only some or none of the products are on sale or discounted at the time of the listing.

The respondent employs the keyboard to enter into a memory of the response unit the identifying numbers of those items for which there is an interest in a future purchase at a sale or discounted price. From time to time over the ensuing days, weeks, or even months, the instructional signal transmits to the response unit an updated listing of the items of merchandise including data of items put on sale or on discount by the manufacturer or retailer. This effectively flags those items which are on sale or available at discount. The computer 804 (or a comparator 372 or 374 in the case of use of the response unit 210 of FIG. 8) compares the respondent’s entries with the flagged items, and then indicates a match by a suitable indication such as by sounding the bell, and by leaving a message on the display 358 of the response unit. The respondent, by command entered at the

keyboard, directs the printer to list the sale or discounted items. Alternatively, respondent enters on the keyboard items desired for purchase and, upon such items being put on sale, the printer of the respondent's response unit prints out coupons conveying a discount on the items without additional commands by respondent. Such discount coupons may be printed even during an absence of the respondent, and will be waiting for the respondent upon his or her return.

[Von Kohorn, col. 99, line 38 – col. 100, line 5].

An important omission is that there is no disclosure in this embodiment that the broadcaster in any way knows what the user has flagged for alerts. Rather, the system of Von Kohorn broadcasts all of the coupons to all of the users. Only if a user has set a preference will an alert be triggered after a coupon is delivered. Thus, there is no determining of a target audience and “providing coupons to a target audience” as claimed.

Further, a comparator in Von Kohorn compares all of the broadcast coupons received by the user's special purpose device and creates an alert if there is a match. Clearly this is a box by box determination. There is no determination of a subset of users at the broadcaster or otherwise. Specifically, this does not disclose “determining a target audience” or “providing a coupon to the target audience determined.” Nor does this disclose that the claimed “providing a coupon to the target audience” further comprises “determining a subset of users of the network based on a preference profile”; and “delivering one or more coupons to the subset of users.” In Von Kohorn, the coupons are delivered (via broadcast) to all users. There is no disclosure in the portion of Von Kohorn relied on in the Decision that says that only coupons of interest are transmitted to a subset of users.

The claim language clearly specifies that the step of providing includes *determining a subset* of users based on a preference profile and *delivering coupons to the subset*. Neither the rejection nor the Affirmance shows that there is a determination of a subset of users, based on a

user preference profile or otherwise, and delivering the coupons to the *determined* subset of users.

Moreover, even if Von Kohorn discloses that user selections are stored, there is no disclosure in the portions relied on that hint that the selections are used to determine whether coupons should be transmitted to the user. This differs from the instant invention where pre-selected coupons are sent directly to a predetermined target audience - a difference that was acknowledged by the Board in an earlier decision as discussed in detail below. For example, Appellants' Specification specifically provides that targeted coupon packages are provide to specific users:

The information stored in the database 11 is input to the marketing and targeting analysis means 17, which carries out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages. That is, it may be determined by the analysis means 17 that users with dogs in their household (which is known by the demographic responses) will get a certain package comprising dog food coupons. It may be further determined that users who select, print and redeem dog food coupons of Brand X will get coupons issued by Brand Y, or will get only low value coupons since they are already dog food coupon users, etc. That is, depending on the marketing and targeting criteria and objectives, the analysis means will generate coupon packages as desired.

Thus, the analysis means generates a number of differing coupon data packages for transmittal to the online service provider 2. The analysis means also provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s). For example, user 1 may be mapped to coupon data packages 2 and 3; user no. 2 to packages 3 and 6, etc. This mapping function may be carried out by the coupon distributor and provided to the online service provider at regular intervals, e.g. once per week. Thus, the coupon selection, printing and redemption habits may be analyzed over a time period and used to determine the subsequent targeted packages.

[Specification, pg. 29, line 14 – pg. 30, line 10].

Additionally, as noted above, the newly cited passages of Von Kohorn refer to a “game

show” embodiment wherein a user is apparently required to perform a task in order to receive an award [Von Kohorn, col. 96, lines 34-35]. Therefore, it is apparently not enough to be part of a broadcast audience to receive a coupon. Rather, a user must somehow earn an incentive. This differs from Appellants’ claimed invention wherein a coupon is *provided* to a target audience based on a determination one or more preferences of the users stored in the respective users’ devices, and not on whether the users have apparently successfully performed a task.

2. *The Decision fails to establish that Von Kohorn discloses monitoring redemption.*

Independent claims 47, 52, 57, and 62 each recite the feature of monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times. Dependent claims 51 and 56 (which depend from independent claims 47 and 52, respectively) recite that monitoring further comprises serializing the coupons such that each coupon may be redeemed once. Independent claim 61 recites the feature of monitoring redemption of the one or more coupons to prevent fraud.

The Decision itself does not address the “monitoring redemption” claim element as a whole. The Board stated that “the examiner responds that Von Kohorn discloses using a coupon a predetermined number of times wherein the predetermined number of times is one” [Decision, pg. 9]. The Board did not address the issue of whether Von Kohorn discloses the claimed *monitoring redemption* for this purpose. This is legal error under 35 U.S.C. § 102(b) because the Board does not address the claim element in its entirety. The Board’s affirmance of this part of the rejection ignores the significance of the *monitoring redemption* part of the claim language.

This omission is significant in the context of the claim (and the invention) as a whole.

Appellants' Specification recites:

Finally, the present invention provides for secure coupon generation by allowing the printing of a particular coupon only once. Further, and quite importantly, the present invention provides for the printing on each coupon of certain user-specific data, thus making each coupon printed unique. Thus, two different users with access to printing a particular coupon will each print coupons with the same product, discount, and expiration date data, yet each will be unique since printed thereon will be user-specific data, preferably in the form of a user-specific bar code. Thus, **any attempts to duplicate via photocopying techniques any particular coupon will be discouraged since the coupon redemption center will detect when a particular coupon has been redeemed**, will identify the user who redeems a particular coupon, and will disallow any attempt at redemption of a second coupon with identical product and user-specific data.

[Specification, pg. 12, line 17 – pg. 13, line 2, **emphasis added**].

Thus, what the invention recognizes, and Von Kohorn does not, is that even if a coupon is unique, multiple copies can be fraudulently redeemed unless the redemptions are monitored. Although Von Kohorn teaches that a manual comparison of a validation card and coupon may be performed at redemption [Von Kohorn, *e.g.*, col. 17, lines 10-25], such a comparison would not be able to detect if fraudulent photocopies of the validation card and coupon were presented.

With regard to dependent claims 51 and 56, the Board's Decision is legally deficient. The Board merely states, "[s]ince we agree with the examiner that Von Kohorn discloses the serializing of coupons [column 85, lines 20-21], and since appellants have not explained why the examiner's position is in error, we also sustain the examiner's rejection of claims 51 and 56" [Decision, pg. 12]. This is error because serializing alone does not meet the claim language. Particularly, there is no support in Von Kohorn for serializing coupons for monitoring redemption.

The relied on recitations in Von Kohorn do not disclose *monitoring* the redeemed coupons. Rather, the cited portion states:

In another embodiment of the methods described, coupons dispensed to winners of an award are provided with first code symbols, said symbols varying from coupon to coupon, an example being consecutive six-digit numbers. The first code symbols may have previously been provided on said coupons, for instance on the coupon tape prior to the insertion of said tape into the coupon generating means. The first code symbols can also be provided on the coupons at approximately the time of or subsequent to the printing of the prize indication. The first and second codes together constitute a winning combination if they match or bear a predetermined correlation, said correlation having been determined by an organized of the broadcast, such as a sponsor, or advertiser. As an example, in the case of a six-digit number code, a correlation may be determined to exist if the last three digits on such a coupon match. Other code forms may be devised. Winning codes or code combinations normally are not intelligible, i.e., not identifiable as a winning code, by a contestant at his location and are revealed to a shopper only at the place of redemption of the prize coupon.

[Von Kohorn, col. 85, lines 18-39].

Thus, first and second code symbols on a given coupon can be visually compared to determine if there is a match of the last 3 digits. However, if the coupon is a photocopy of a valid coupon, the fraudulent copy will, upon visual inspection, appear to be valid based on the 3 digit match. This failure to prevent fraud in Von Kohorn highlights a distinction between the claimed invention and Von Kohorn. It further reflects the legally flawed approach that the Examiner has taken with this case - finding a topic of interest (*e.g.*, serializing coupons) and ignoring the context in which it is disclosed versus the claim element (and invention) as a whole.

Merely serializing coupons does not meet the claim language. In Von Kohorn if a coupon does not having matching codes, redemption is refused. Von Kohorn does not recognize or address the problems addressed by the invention relating to fraud due to photocopying coupons. Most certainly, the portion of Von Kohorn relied on in the affirmance does not disclose

monitoring redemption to ensure that a coupon is only used once. Rather, it simply addresses whether a document presented (whether original or copy) has matching codes. The problem is if it matches on the original, it will match on the copy.

For each of the foregoing reasons, the Board's new rejection of independent claims 47, 52, 57, 61, and 62 under 35 U.S.C. § 102(b) is improper and should be reversed. Dependent claims 48-51, 53-56, and 58-60 are allowable for at least the reason that they depend from allowable independent claims (for the reasons set forth above), as well as for the further limitations they contain. At a minimum, Appellants request that the Decision be vacated and remanded to the Examiner for further consideration of the newly cited passages in Von Kohorn relied upon by the Board.

D. THE BOARD'S INTERPRETATION OF VON KOHORN CONFLICTS WITH AN EARLIER DECISION IN A RELATED, CO-PENDING APPLICATION.

In the new ground of rejection discussed above, the Board's interpretation of Von Kohorn conflicts with the Board's findings in an earlier decision in a related, co-pending application. In the current Decision, at pg. 10, the Board alleged that Von Kohorn discloses an embodiment in which a user can select a product area of interest and, subsequently, receive an award in the form of a coupon allowing him to purchase a product in the area of interest.

This finding is in conflict with the Decision in Ex Parte Barnett, No. 2005-2251 (B.P.A.I. Dec. 12, 2005) ("Prior Decision"), wherein the Board recites, at pg. 9:

Most importantly, we agree with appellants that the downloading of coupon information in Von Kohorn is not based upon the potential consumer indicating an interest in the product. Coupon information in Von Kohorn is downloaded regardless of whether the consumer has an interest in the product.

The Prior Decision is correct³. Von Kohorn is a broadcast system which initiates transmissions to a broadcast audience. As discussed in detail above, Von Kohorn broadcasts discount information to response units of all users --not just to targeted users-- where the determination is *then* made whether or not a particular discount matches a selected user interest. Accordingly, rehearing is requested for clarification of the contradictory findings of the Board with respect to the disclosure of Von Kohorn.

E. THE BOARD ERRED BY INCONSISTENTLY INTERPRETING CLAIM LANGUAGE FOR PURPOSES OF ANTICIPATION AND LACK OF WRITTEN DESCRIPTION.

The Board erred by inconsistently interpreting the claim language “predetermined number of times” for purposes of finding anticipation under 35 U.S.C. § 102(b) and lack of written description under 35 U.S.C. § 112, ¶1. If the Board’s interpretation of the recitation of “predetermined number of times” is applied consistently, then either the rejection under 35 U.S.C. § 112, ¶1 is improper, or the rejection under 35 U.S.C. § 102(b) is improper. The two rejections, however, cannot stand together.

Independent claims 47, 52, 57, & 62 are rejected under 35 U.S.C. § 112, ¶1 for allegedly lacking support in the Specification for the phrases wherein each coupon may be used “a predetermined number of times,” and monitoring redemption of the one or more coupons such that each coupon may be used “a predetermined number of times.” In sustaining the rejection under

³ Arguably, because Von Kohorn is a broadcast system, the coupons are not downloaded, but rather transmitted. Nevertheless, as a result they are *provided* to each user.

35 U.S.C. § 112, ¶1, the Board cited two possible interpretations of the foregoing phrases, and adopted the first interpretation:

The first interpretation is that each printed coupon given to one user can be used a predetermined number of times. This interpretation is the one accepted by the examiner and appears to be the interpretation initially argued by appellants. This interpretation is not supported by the specification because the specification, as argued by the examiner, suggests that each printed coupon is to be used only one time to avoid fraud.

[Decision, pg. 5].

The Board sustained the rejection because Appellants' specification allegedly allows each printed coupon to be used only once, which the Board concluded does not support the recitation of a "predetermined number of times." The Board took an inconsistent position, however, when sustaining the rejection under 35 U.S.C. § 102(b):

With respect to the recitation that each coupon may be used a predetermined number of times, we agree with the examiner that Von Kohorn clearly teaches that each coupon may be used only one time, such that the predetermined number is one.

[Decision, pgs. 10-11].

This is improper. As the Board correctly noted in the Decision, anticipation under 102(b) requires express or inherent disclosure of each and every element of a claimed invention [Decision, pgs. 7-8]. Neither the Examiner nor the Board has pointed to any *express* disclosure in Von Kohorn of limiting use of a coupon to a "pre-determined number of times." Clearly this phrase is not used. Instead, the Board expressly adopts the Examiner's premise that Von Kohorn only discloses using the coupon once and agreed that this satisfies "using a coupon a predetermined number of times wherein the predetermined number is one" [Decision, pg. 9].

Since there is no express disclosure of “a predetermined number of times” in Von Kohorn, the only remaining legal basis that the Board can rely on to assert that this claim element is disclosed by Von Kohorn, is inherency. However, if the Board interprets a disclosure of using a coupon once as an inherent disclosure of “a predetermined number of times,” then the disclosure in Appellants’ specification is also an inherent disclosure.⁴

To the extent this is not an inherent disclosure, then there is no basis for the rejection under 35 U.S.C. § 102(b). For at least this reason, at least one of the Board’s rejections under 35 U.S.C. § 112, ¶1 and 35 U.S.C. § 102(b) should be reversed. At a minimum, rehearing is requested for clarification of the Board’s inconsistent interpretation of the claim language.

F. THE BOARD ERRED BY IMPROPERLY IMPORTING A LIMITATION INTO THE CLAIMS.

The Board erred by dismissing Appellants’ alternative argument under 35 U.S.C. §112, ¶1 by improperly reading limitations into the claims. To satisfy the written description requirement of 35 U.S.C. §112, first paragraph, an applicant must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-1564, 19 U.S.P.Q. 2d (BNA) 1111, 1117 (Fed. Cir. 1991) (emphasis in original).

Appellants argued in the alternative that the phrases “wherein each coupon may be used a pre-determined number of times,” and “monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times” are supported (in the

⁴ The Decision alleges that Appellants’ specification discloses using each printed coupon once.

specification) by an implementation wherein coupon packages are mapped to various users, thereby limiting redemption of each coupon in the package to a predetermined number of times corresponding to the number of users in the group [Reply Brief, pg. 3].

The Board dismissed this interpretation, however, by erroneously focusing on the feature of mentoring redemption to “prevent fraud,” which is not recited in any of independent claims 47, 52, 57, & 62:

In the reply brief, appellants assert the second interpretation. This interpretation suggests that the predetermined number recited in the claims refers to the total number of coupons issued to all targeted users. Although this interpretation might be consistent with the claim language, it appears to be completely unrelated to anything found in the disclosure. **That is, we can find nothing in appellants’ specification to suggest that the total number of issued coupons is monitored to prevent fraud.** Thus, this second interpretation appears to be an interpretation recently devised by appellants in an attempt to render these claims patentable. Given these two completely different interpretations of the claim language, we decline to accept an interpretation which lacks any support or recognition in the specification as filed.

[Decision, pgs. 5-6, **emphasis added**].

The Board’s focus on fraud prevention is irrelevant to the determination of whether the written description requirement is satisfied, since there is no claim language relating to “fraud prevention” in the claims at issue. As such, it constitutes clear legal error for the Board to have dismissed this interpretation by focusing on a feature that is not recited in the claims.

Moreover, Appellants note that there is ample support in the as-filed specification for monitoring the total number of coupons redeemed. This may be done, for example, to more intelligently market subsequent coupons and target coupon issuance in a more cost-effective manner [specification, pg. 11, lines 25+].

For the foregoing reasons, the Board's rejection under 35 U.S.C. § 112, ¶1 should be reversed. At a minimum, rehearing is requested so that the Board may focus on the issue of support in the written description for the language that is claimed.

V. CONCLUSION

In sustaining the rejection of claims 47-62 under 35 U.S.C. § 102(b), the Board erred by using a newly-devised rationale to which Appellants must be afforded an opportunity to respond, and by interpreting the relied-upon reference in a manner that directly conflicts with an earlier Board Decision in a related, co-pending application. The Board further erred by inconsistently interpreting claim language for purposes of anticipation and lack of written description. In sustaining the rejection of claims 47-62 under 35 U.S.C. § 112, ¶1, the Board erred by improperly importing limitations into the claim. Additionally, the Board wrongly sustained a rejection of a claim based on alleged "unsupported" features that it does not recite. For each of these reasons, Appellants respectfully request favorable consideration of this Request for Rehearing, and reversal of the rejection of claims 47-62 under both 35 U.S.C. § 102(b) and 35 U.S.C. § 112, ¶1. At a minimum, Appellants request that the Decision be vacated and remanded to the Examiner for further consideration.

Request for Rehearing Under 37 C.F.R. § 41.52
U.S. Application Serial No. 09/879,823
Appeal No. 2005-2686

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Respectfully submitted,



By: Reg. NO. 47,429
James G. Gatto
for: Registration No. 32,694

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Direct Dial: 703-770-7754
Main: 703-770-7900
Fax: 703-770-7901